UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR		ATTORNEY DOCKET NO.
08/828,330	03/28/97	MORGAN	W	1-852-002

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EXAMINER	
CANFIELD,R	
ART UNIT	**PAPER NUMBER**
3621	

DATE MAILED: 03/09/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
08/828,330	Morgan3
Examiner	**Group Art Unit**
Robert Canfield	3621

☒ Responsive to communication(s) filed on *Mar 28, 1997* .

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-48* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-48* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. This is a first Office action on the merits for application serial number 08/828330 filed 3/28/97 as a reissue of application serial number 08/139835, U.S. Patent 5,400,549. Claims 1-48 are pending.

2. The examiner questions if the patent sought to be reissued by this application is involved in litigation. If so, any documents and/or materials which would be material to the patentability of this reissue application are required to be made of record in reply to this action.

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the loops projecting both above and below the panels, the cable anchored at either of its ends to anchoring means, the anchoring trench, the cover supported above a pond, aqueous solution, and tank must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 2, 9, 21, 27, and 43 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no disclosure or showing in figures of the loops disposed through the grommets projecting both above and below the panel units.

There is an inadequate written description of the broad recitation of a means for controlling temperature. Only insulation is ever disclosed.

There is no description or showing of an anchoring trench.

There is no description or showing of the cover overlying a tank.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 "the entire row of said loops" lacks antecedent basis rendering the claims vague and indefinite.

It is unclear how claim 3 further limits claim 1 from which it depends.

8. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2173.05(l). The omitted elements are: clamp means 11.

It is unclear how the means for linking and securing can function with only a loop and cable .

9. Claims 2, 9, 21, 27, and 43 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

The grommets projecting both above and below the panel units.

Means for controlling temperature. Only insulation is ever disclosed.

Anchoring trench.

The cover overlying a tank.

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

11. Claims 5-7, 9, 10, 12-19, 23-29, 31-33, 35-41, 44, and 45-48 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,590,714 to Walker.

See entire description. Particularly note figures 2 and 3.

Note the recitation "A pond cover" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Also note that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

The cover of Walker meets all positively recited structural limitations of the above claims and is capable of covering, a waste treatment pond or tank.

12. Claims 5-7, 9, 13-15, 18-20, 22, 24-29, 31, 36-42, 45, 47, and 48 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 5,197,239 to Glynn et al.

See the entire disclosure.

Again note the remarks above concerning preambles and intended use.

Concerning claim 9 the cover itself is a means for controlling temperature.

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. Claims 8, 11, 20, 22, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,590,714 to Walker.

Walker provides all of the elements/steps of these claims except for specifying the particular dimensions, making the seams from a weld, and showing the tie down cable.

The dimensions of the panels are nothing more than choices of design which would have been obvious at the time of the invention to one having ordinary skill in the art. One of ordinary

skill in the art would have readily recognized that the panels of Walker could be varied in size to meet particular needs.

Walker discloses a seam, preferably a stitched seam. However welded seams are well recognized art equivalents to plastic seams when joining sheets of plastic material> It would have been an obvious substitution of mechanical equivalents at the time of the invention to one having ordinary skill in the art to have substituted a welded seam for the stitched seam of the panels of Walker.

While Walker fails to show his panels tied down with cable anchoring means he does suggest in the background of the invention that it was well known at the time of the invention to hold panels down with ropes. This would suggest to one having ordinary skill in the art that Walker had intended his panels to be tied or anchored down with cables such as ropes through the grommets and loops of the fastening device shown in figure 3.

15. Claims 1-4 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action.

The specific linking and securing means recited in the claims is not taught or adequately suggested in the prior art of record.

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patents 5,546,615 to Chamness and 5,562,759 to Morgan et al. Are each closely related to the instant invention but fails to qualify as prior art references.

Other prior art panel covering systems having features similar to those disclosed and claimed by applicant are listed. All of the references have at least a linking and delinking feature in common.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Canfield whose telephone number is (703) 308-2168.

Robert Canfield
February 27, 1998

ROBERT CANFIELD
PRIMARY EXAMINER
GROUP 3500